UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/829,721
Filing Date: April 10, 2001
Appellant(s): SMITH ET AL.

Michael E. Hudzinski of Fay, Sharpe, Fagan, Minnich &McKee, LLP
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/23/2006 appealing from the Office action

mailed 3/20/2006

(1) Real Party in Interest

The statement of the Real Party in Interest contained in the brief is correct.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial

proceedings which will directly affect or be directly affected by or have a bearing on the

Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection

contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

- Microsoft Word 2000, copyright 1983-1999 by Microsoft Corporation (hereinafter MS Word) Note: screen shots of the software application running on the examiner's computer workstation are used as prior art.

- William B. Hayes Using PowerBuilder 6, published by QUE Corporation in 1997, (hereinafter PowerBuilder 6).

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

- Claims 2, 3, 6-8, 11-13, 15, 16, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over MS Word, in view of PowerBuilder 6.

(10) Response to Argument

Appellant argues that there is lack of motivation to combine MS Word and PowerBuilder 6 (page 7, last paragraph of the Appeal Brief filed 10/23/2006). MS Word is a well-known word processing program that is replete with graphical user interface (GUI) objects, where the GUI objects provide efficiency for entering and managing the data associated with the document. PowerBuilder 6 is a tool that is used to build GUI objects for various software applications. The two references are analogous art references.

MS Word discloses a text entry dialog box system in a typical computer system. As is well know in the art, a typical computer system would include a display device, a pointing device (usually in the form of a mouse), memory devices, and a processor that executes an application program that would be displayed on the display. MS Word further discloses a text entry space in a dialog box that accepts free form text entry in Figures 5-7.

Figure 5 is the Find and Replace box available from the Edit menu, where the user has not yet entered any search terms. Figure 5 discloses a text entry space in a dialog box displayed on a screen of the display device for free form entry of text by the user. The memory associated with this dialog box is initialized as empty (this memory is initialized as empty each time the MS Word application is started). The empty memory initialization is disclosed in Figure 6 (shown as an empty list).

Figure 7 discloses a user entry of text. The text is stored in memory. The user subsequently entered additional text items (shown in the list of Figure 8). In Figure 8, MS Word discloses displaying a list of previously entered text items that had been stored in memory. To access this list of previously entered text items, the user would select the show-list-button (displayed as a square box with a downward pointing arrow). The show-list-button is well known in the industry.

MS Word fails to disclose the selective display of a selection button (i.e. the show-list-button) associated with the dialog box, where the selection button is visible when at least one text entry is stored in memory. In the examples described above the show-list-button is always displayed. PowerBuilder 6 discloses dialog box controls that have intelligence built into them wherein the controls are conditionally displayed based upon the volume of items in memory. PowerBuilder 6 discloses controls built into the drop down box selection button (the arrow) on page 3. PowerBuilder recites: *"Always Show Arrow: The Always Show Arrow checkbox always shows the arrow that opens the list box. If Always Show Arrow is unchecked, the arrow is shown only when the column has focus."* PowerBuilder 6 discloses conditional program execution related to visibility of the arrow.

PowerBuilder 6 further discloses the conditional program execution of the visibility of controls in relation to the volume of data in the memory of the list box on page 2. PowerBuilder 6 recites: *"Disable Scroll: If Disabled Scroll is checked, the scroll bar will always be visible but will be disabled when you can access all*

the items without scrolling. If this property is not checked, the scroll bar will be displayed only if necessary, based on the number of items and the height of the listbox." So, if the listbox is set to a height equivalent to less than one line of text, and the memory is empty, then the scroll bar would not be displayed. Furthermore, in this example, if the memory holds one or more text items, the scroll bar would be visible. PowerBuilder 6 discloses selectively displaying a text entry box control, wherein the selective displaying is based upon the items stored in memory.

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made to modify the MS Word Find and Replace text entry dialog box with the selectively displayed controls as taught by PowerBuilder 6 in order to provide a visible indication that the control is usable.

Appellant argues that the motivation to combine MS Word and PowerBuilder 6 is taken from the present application (page 9, last paragraph of the Appeal Brief filed 10/23/2006). However, PowerBuilder 6 provides additional motivation to combine the references. Power builder recites: *"Allow Editing: Sometimes you'll want to give the user a list of choices, but other times you'll want the user to be able to type in his or her own choice. Checking **Allow Editing** enables the user either to select a choice from the list box or to type in a new choice"* (PowerBuilder 6, page 3, second paragraph).

The examiner would point out that appellant's arguments describe inventive features that are not claimed. Appellant states: *"Confused users may*

also fail to recognize the free-form text entry option (which is the only viable option upon initially opening the dialog window)" (page 6, last paragraph of the Appeal Brief filed 10/23/2006). However, the claimed invention indicates that the state of the memory dictates weather the selection button is displayed, so that opening the dialog window has two possible conditions depending on whether the memory is empty or not empty. So, although appellant asserts *"the only viable option upon initially opening the dialog window"*, there are actually two viable options when opening the dialog window, if the memory is empty, then the button is not displayed, but if the memory is not empty, then the button is displayed. It is not clear that the confusion appellant is trying to overcome with their invention is actually achieved.

The examiner agrees with appellants' generalization of the claimed invention as *"claims 2, 8 and 21 describe the coupling of input features and the list viewing features"* (page 9, second paragraph of the Appeal Brief filed 10/23/2006). PowerBuilder 6 clearly shows features that can be built in to the dialog box that associate data input with list viewing features.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.
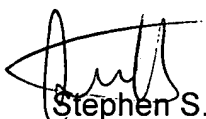
Respectfully submitted,

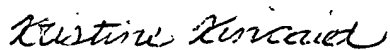Gregory J. Vaughn
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February 16, 2006

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